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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,668	02/20/2004	Gabriel Santos	IS01442ESG	7224
20280	7590	01/09/2006	EXAMINER	
MOTOROLA INC 600 NORTH US HIGHWAY 45 ROOM AS437 LIBERTYVILLE, IL 60048-5343			PRONE, JASON D	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 01/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/783,668

Applicant(s)

SANTOS ET AL.

Examiner

Jason Prone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 7, 8, and 10-13 are rejected, as best understood, under 35 U.S.C. 102(b) as being anticipated by Coleman (3,675,524).

In regards to claim 1, Coleman discloses the same invention including a means for holding a work piece (23), a cutting means (17 and 27) comprising at least one blade (17), the blade passes across at least one surface of the work piece (Fig. 2),

In regards to claim 2, Coleman discloses the cutting means further comprises a leveling means (27).

In regards to claim 3, Coleman discloses the amount of insertion is limited by the leveling means (Fig. 1).

In regards to claim 7, Coleman discloses a sliding member coupled to the cutting means (12) and the sliding member is mounted on rails (Fig. 3).

In regards to claim 8, Coleman discloses the sliding member is coupled to a lever (13).

In regards to claim 10, Coleman discloses a threaded member coupled to the sliding member (7) and the threaded member passes through a fixed stop (5).

In regards to claim 11, Coleman discloses a threaded stop disposed about the threaded member (8) such that the fixed adjustment stop is disposed between the sliding member and the threaded stop (Fig. 2).

In regards to claim 12, Coleman discloses travel of the cutting means is adjustable by twisting the threaded stop (8).

In regards to claim 13, Coleman discloses the cutting means is electrically isolated from the means for holding a work piece (Fig. 2).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Makeev et al. (4,077,287). Coleman discloses the invention but fails to disclose a magnet mounted below the cutting means. Makeev et al. teaches a magnet below the cutting means (39 Column 10, lines 20-25). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a magnet, as taught by Makeev et al., to prevent the cut pieces from traveling all over.

5. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Diskin (5,135,208). Coleman discloses the invention but fails to disclose the means for holding includes a fixed block and a spring-loaded belt. Diskin

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teaches a means for holding that includes a fixed block (22) and a spring-loaded (64) belt (52). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a fixed block and a spring-loaded belt, as taught by Diskin, to allow the holding means to hold an alternate shaped work piece.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Matych (1,164,658). Coleman discloses the invention but fails to disclose the lever is rotatably connected to the sliding member by way of a gear assembly. Matych teaches a lever (27) that is rotatably connected to the sliding member (24) by way of a gear assembly (Figs. 3 and 4). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a gear assembly, as taught by Matych, to allow for a more precise method of moving the sliding member.

7. Claims 15, 16, and 18 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Diskin. Coleman discloses the invention including a base member (1), a fixed block coupled to the base member (23), a moveable cutting means comprising at least one blade (17), a leveling means (27), and the cutting means is electrically isolated (17).

However, Coleman fails to disclose the fixed block includes a recess for holding the work piece, a spring loaded moveable belt, and the belt and the recess form a closed loop. Diskin teaches a fixed block (22) with a recess for holding the work piece (30), a spring-loaded (64) moveable belt (52), and the belt and the recess form a closed

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loop (Fig. 5). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman with a fixed block and a spring-loaded belt, as taught by Diskin, to allow the holding means to hold an alternate shaped work piece.

8. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coleman in view of Diskin as applied to claim 15 above, and further in view of Makeev et al. Coleman and Diskin disclose the invention but fail to disclose a magnet disposed below the cutting means. Makeev et al. teaches a magnet below the cutting means (39 Column 10, lines 20-25). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Coleman in view of Diskin with a magnet, as taught by Makeev et al., to prevent the cut pieces from traveling all over.

### ***Response to Arguments***

9. In response to applicant's argument that Coleman fails to disclose that the means for holding is equipped to hold a battery cell, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The fact that the holding means holds a battery is the intended use of the apparatus. The Coleman patent is perfectly capable of holding a battery. It is old and well known that batteries come in all shapes and sizes. In fact, the work piece (25) shown in Coleman could represent a battery of some kind.

Diskin teaches to Coleman that it is old and well known in the art of holding a work piece to incorporate a belt and fixed block apparatus for an alternate way of stabilizing a work piece to be held.

In Coleman, item 27 in Figure 2 clearly limits the amount of insertion of the work piece and clearly keeps the work piece level. The term "level" could represent any orientation of the work piece. The term level has not been defined and has been given its broadest interpretation.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

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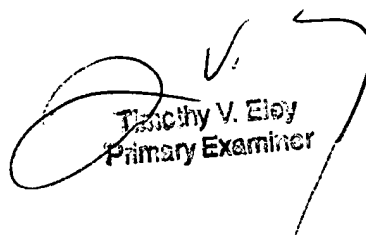
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (571) 272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JP

January 02, 2006



Timothy V. Eloy  
Primary Examiner